

(V)

thereby to produce the compound of Formula II.

Remarks

Rejection Under 35 U.S.C. §112, First Paragraph

Claims 44 and 45 have been rejected as lacking support in the written description for reciting "in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride." Applicants respectfully traverse the rejection for the following reasons.

In issuing a rejection based on a lack of written description, the Examiner bears a burden, as set forth in the MPEP § 2163.04:

"If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." MPEP § 2163.04 (emphasis added)

This is entirely consistent with the pronouncements of the Courts on the written description requirement. "Precisely how close [to the claimed invention] the description must come to comply with Sec. 112 must be left to a case-by-case development." In re Smith, 458 F.2d 1389, 1395 (C.C.P.A. 1972). To date, this burden has not been taken up by the Examiner.

Applicants respectfully submit that one of ordinary skill in the art, at the time of the filing of the invention, would have been reasonably apprised that applicants were in

possession of the invention claimed in pending claims 44 and 45. The pending claims are essentially to a process for making a compound of Formula I, comprising reacting a compound of Formula VI' (claim 44) or Formula VI (claim 45) with a compound of Formula V "in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride."

Viewing the general process description of this conversion (Scheme II, page 11), and example on page 16, lines 5-11 pertinent to this conversion, one of ordinary skill in the art would conclude that each of the compounds of claims 44 and 45 could be prepared in this way, and that this was reasonably conveyed by applicants at the time of filing. That is, compounds within the scope of the pending claims "can also be prepared by condensation of the piperazines of Formula V with the anhydrides of Formula IV." (page 11, lines 3-5) One of ordinary skill in the art could then look to the examples for further guidance as to the particular teachings of applicants' specification. One of ordinary skill in the art would understand that this reaction, taking place "in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride" represents general reaction conditions for transformations described in Scheme II.

As pointed out above, the Examiner bears the burden of setting forth reasoning explaining why one of ordinary skill in the art would not recognize that applicants teach a procedure for creating the compounds of Formula I (claim 44) or Formula II (claim 45) by reacting a compound of Formula VI' (claim 44) or VI (claim 45) with a compound of Formula V "in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride."

Applicants submit that the claims are supported by the disclosure as filed, and respectfully request reconsideration and withdrawal of the rejection. This would overcome all outstanding rejections and result in allowable claims.

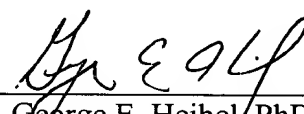
Conclusion

In view of the foregoing, Applicants believe that the present application is now in condition for allowance and respectfully request consideration thereof. A clean copy of claims as amended is submitted herewith, and authorization is hereby given to charge any fees deemed to be due in connection with this Amendment Accompanying Request for Continued Examination to Deposit Account No. 50-0912.

Respectfully submitted,

ANAND *et al.*

By: _____

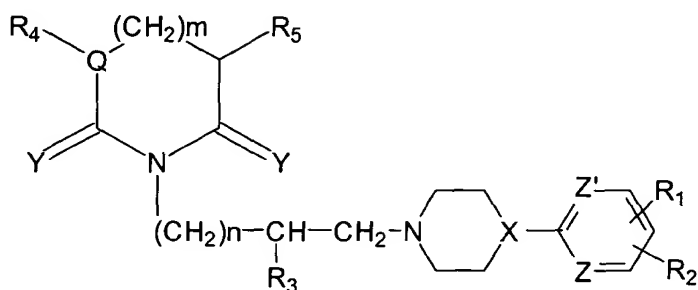

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Date: October 28, 2002

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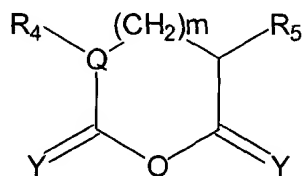
Amended Claims 44 and 45 for 09/578,239 as of October 22, 2002

44. (Thrice Amended) A method for making a compound having the structure of Formula I



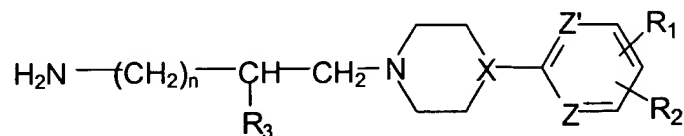
(I)

its pharmaceutically acceptable salts, enantiomers, diastereomers, or N-oxides, wherein Y is O or S; Q, Z and Z' are independently CH; X is CH or N; $m=0-3$; $n=0-4$; R₁, R₂ are independently selected from: H, F, Cl, Br, OCH₃, OC₂H₅, OCH₂CF₃, SCF₃, CH₃, C₂H₅, CF₃, isopropoxy, and cyclopropyl; and R₃, R₄ and R₅ are independently H, C₁₋₃ alkyl, substituted or unsubstituted phenyl, [except when R₁-R₅ are H; m is 0; n is 2; Q is CH; X is N; Y is O; Z and Z' are CH, and except when R₁ is H; R₂ is H; Cl or CH₃; R₃-R₅ are H; m is 0; n is 1; X is N; Y is O; Z and Z' are CH,] which comprises reacting a compound having the structure of Formula VI'



(VI')

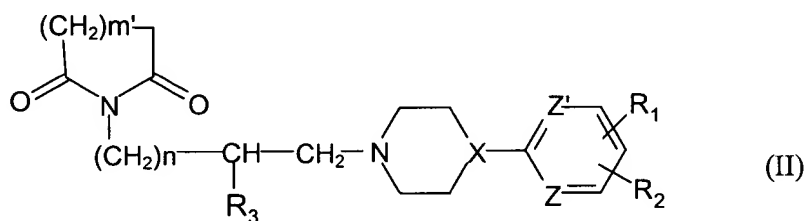
with a compound having the structure of Formula V in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride



(V)

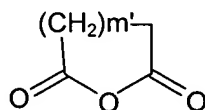
thereby to produce the compound of Formula I.

45. (Twice Amended) A method for making a compound having the structure of Formula II



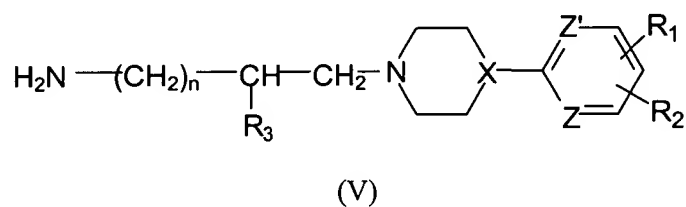
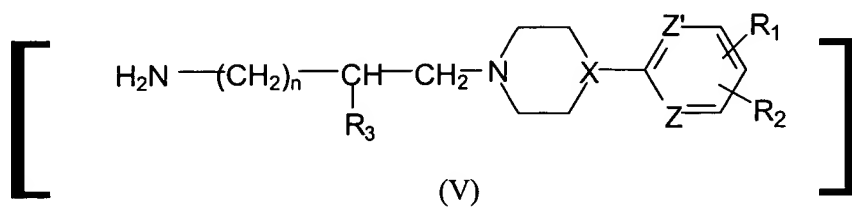
(II)

its pharmaceutically acceptable salts, enantiomers, diastereomers, or N-oxides, wherein X is CH or N; Z and Z' are independently CH; n= 0-4; m' [-] 1-4; R₁, R₂ are independently selected from: H, F, [CL]CL, Br, OCH₃, OC₂H₅, OCH₂CF₃, SCF₃, CH₃, isopropoxy, and cyclopropyl; and R₃ is independently H, C₁₋₃ alkyl, substituted or unsubstituted phenyl, [except when R₁-R₃ are H; n is 2; X is N; Z and Z' are CH, and except when R₁ is H; R₂ is H, Cl or CH₃; R₃ is H; n is 1; X is N; Z and Z' are CH] which comprises reacting a compound having the structure of Formula VI



(VI)

with a compound having the structure of Formula V[.]in pyridine at reflux temperature followed by reflux in the presence of acetic anhydride



thereby to produce the compound of Formula II.